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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,085	01/14/2002	Stephen F. Gass	SDT 323	6609

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EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 01/14/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/050,085

Applicant(s)

GASS ET AL.

Examiner

Boyer D. Ashley

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,5-9 and 19 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-18 and 20 is/are allowed.
- 6) ☒ Claim(s) 1,4 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4-8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

It should be noted that for the purpose of this office action the below rejections under 35 U.S.C. 101 (double patenting) are being made under the assumption that the applications were not commonly owned at the time of applicant's invention. It should further be noted that rejections under 35 U.S.C 102(a) and 102(e) using the same U.S. Patent Applications/Publications have not been made because they do qualify as prior art as their filing dates are not before the filing date of the instant application.

Additionally, it should be noted that double patenting rejections made or not made are based upon known and available co-pending applications and although it is believed that all appropriate rejections have been made, Applicant's help in determining all appropriate double patenting rejections with all of Applicant's applications is requested because of the large number of similar applications.

Election/Restrictions

1. Applicant's election of Group IV (claims 1, 4, 10-14, 15-18, 20) in Paper No. 10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 2-3, 5-9, and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.

Priority

3. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(e) and 35 U.S.C. 120. See 37 CFR 1.78.

SPECIAL CIRCUMSTANCES OF THIS APPLICATION:

4. Even if a copending application is listed as a parent to the instant application and material information is technically of record in one or more parent applications, the unusually large number of applicant's cases in varying stages of the examination process might result in one or more parent applications not being readily available for review, or material information of record not being readily apparent. Applicant should point out such material information to the examiner of the instant application if the criteria for materiality applies, and if the examination record provides applicant reason to believe such information has not been considered by the examiner.

If, to the best of applicant's knowledge, applicant has no previous patent or copending application, which would meet the definition of "material," applicant is requested to make a statement of that fact of record.

Any parent application labeled as a CIP or Divisional is assumed to claim a patentably distinct invention from the claims of this application and therefore the issue of double patenting has not been considered and the rights to priority are limited to the common disclosed subject matter unless it is brought to the examiners attention that some claims are not distinct.

37 CFR 1.56 is cited here:

37 CFR 1.56. Duty to disclose information material to patentability.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
 - (i) Opposing an argument of unpatentability relied on by the Office, or
 - (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 4, and 10-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/929,238, U.S. Patent Application Publication 2002/0017179. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1, 4, and 10-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/047,066, U.S. Patent Application Publication 2002/0056348. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1, 4, and 10-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-20 of copending Application No. 10/052,274, U.S. Patent Application Publication 2002/0059854 in view of Shiotani et al. or Suzuki et al.

This is a provisional obviousness-type double patenting rejection.

The claims of 14-20 of copending application '274 discloses the invention substantially as claimed except for the first and second linkage assemblies; however, Suzuki et al. and Shiotani et al. both disclose that it is old and well known in the art to use multiple linkage assemblies with miter saws for the purpose of facilitating cutting of larger boards than a typical miter saw. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to claim first and second

linkage assemblies with the miter saw of claims 1, 4, and 10-11 of application '274 in order to facilitate cutting larger boards.

9. Claims 1, 4, and 10-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/052,806, U.S. Patent Application Publication 2002/0059855 in view of Shiotani et al. or Suzuki et al.

This is a provisional obviousness-type double patenting rejection.

The claims of 1-18 of copending application '806 discloses the invention substantially as claimed except for the first and second linkage assemblies; however, Suzuki et al. and Shiotani et al. both disclose that it is old and well known in the art to use multiple linkage assemblies with miter saws for the purpose of facilitating cutting of larger boards than a typical miter saw. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to claim first and second linkage assemblies with the miter saw of claims 1, 4, and 10-11 of application '274 in order to facilitate cutting larger boards.

10. Claims 1, 4, and 10-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/051,782, U.S. Patent Application Publication 2002/0066346 in view of Shiotani et al. or Suzuki et al.

This is a provisional obviousness-type double patenting rejection.

The claims of 1-20 of copending application '782 discloses the invention substantially as claimed except for the first and second linkage assemblies; however,

Suzuki et al. and Shiotani et al. both disclose that it is old and well known in the art to use multiple linkage assemblies with miter saws for the purpose of facilitating cutting of larger boards than a typical miter saw. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to claim first and second linkage assemblies with the miter saw of claims 1, 4, and 10-11 of application '274 in order to facilitate cutting larger boards.

11. Claims 1, 4, and 10-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/052,273, U.S. Patent Application Publication 2002/0059853 in view of Shiotani et al. or Suzuki et al.

This is a provisional obviousness-type double patenting rejection.

The claims of 1-15 of copending application '274 discloses the invention substantially as claimed except for the first and second linkage assemblies; however, Suzuki et al. and Shiotani et al. both disclose that it is old and well known in the art to use multiple linkage assemblies with miter saws for the purpose of facilitating cutting of larger boards than a typical miter saw. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to claim first and second linkage assemblies with the miter saw of claims 1, 4, and 10-11 of application '274 in order to facilitate cutting larger boards.

12. Claims 1, 4, and 10-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-10

of copending Application No. 10/100,211, U.S. Patent Application Publication 2002/0170399 in view of Shiotani et al. or Suzuki et al.

This is a provisional obviousness-type double patenting rejection.

The claims of 2-10 of copending application '274 discloses the invention substantially as claimed except for the first and second linkage assemblies; however, Suzuki et al. and Shiotani et al. both disclose that it is old and well known in the art to use multiple linkage assemblies with miter saws for the purpose of facilitating cutting of larger boards than a typical miter saw. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to claim first and second linkage assemblies with the miter saw of claims 1, 4, and 10-11 of application '274 in order to facilitate cutting larger boards.

Comments on Commonly Assigned Applications

13. Claims 1, 4, and 10-11 are directed to an invention not patentably distinct from the claims, see above, of commonly assigned applications, for the reasons stated above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned applications, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37

CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1, 4, and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the expression "may be" in the phrase "... so that the housing may be moved toward and away from the cutting zone" is indefinite, in that, it is not clear if the housing is moved toward and away from the cutting zone or not. Better language would be "... so that the housing is movable toward and away from the cutting zone".

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3724

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

17. Claims 1, 4, and 10-11 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

It is not clear who actually invented the subject matter of claims 1, 4, and 10-11 because each of the above co-pending applications have different inventive entities. Therefore, it is not clear which portion of the applications where invention by the same inventive entity of the instant application.

18. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al., U.S. Patent 5,791,224.

Suzuki et al. discloses the same invention as claimed including, e.g., a base assembly (1/2a/4-5/8) defining a cutting zone (see area around sign 18 in Figure 11); a first linkage assembly (10 or 206) pivotably coupled to the base assembly; a second linkage assembly (22 or 16 or 214 or 204) pivotably coupled to the base assembly; a housing (13/209) having at least a first region (around 12 or 208) pivotally coupled to the first linkage assembly and at least a second region (13a or 13b or 209a or 210) pivotally coupled to the second linkage assembly, where the first and second linkage assemblies couple the housing to the base so that the housing may be moved toward and away from the cutting zone; a motor (see column 6, lines 20-30) mounted on the housing; and a rotatable blade (15) coupled to be driven by the motor to cut workpieces within the cutting zone when the housing is pivoted toward the cutting zone.

Art Unit: 3724

19. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Shiotani et al., U.S. Patent 5,257,570.

Shiotani et al. discloses the same invention as claimed including, e.g., a base assembly (1 or 104a or 104 or 224) defining a cutting zone (see area around sign 101 in Figure 8); a first linkage assembly (106 or 226) pivotably coupled to the base assembly; a second linkage assembly (117 or 114 or 234 or 227) pivotably coupled to the base assembly; a housing (119 or 236) having at least a first region (around 118 or 228) pivotally coupled to the first linkage assembly and at least a second region (119a or 235) pivotally coupled to the second linkage assembly, where the first and second linkage assemblies couple the housing to the base so that the housing may be moved toward and away from the cutting zone; a motor (see columns 5 and 7, lines 1-10 and 64-67, respectively) mounted on the housing; and a rotatable blade (5) coupled to be driven by the motor to cut workpieces within the cutting zone when the housing is pivoted toward the cutting zone.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 4 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. in view of Lokey, U.S. Patent 3,785,230.

Suzuki et al. discloses the invention substantially as claimed except for: the detection system configured to detect a dangerous condition between a person and the blade; and a reaction system having at least one brake member configured to engage and stop the rotation of the blade in the event a dangerous condition is detected. However, Lokey discloses that it is old and well known in the art to use a detection system (15/16/18/19/20) and a reaction system (21/24/29) that includes at least one brake member (e.g. 24) for the purpose of preventing injury to a user (see column 1, lines 1-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a detection system and a reaction system, as taught by Lokey, in order to prevent injury to a user upon detection of a dangerous condition between the user and the blade.

As to claim 11, the modified device Suzuki et al. discloses a miter saw braking system wherein the rotating blade includes angular momentum when rotating such that at least a portion of the angular momentum is transferred to the first linkage assembly when the brake member engages the blade because the first linkage assembly is connected to the housing holding the blade.

22. Claims 4 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiotani et al. in view of Lokey, U.S. Patent 3,785,230.

Shiotani et al. discloses the invention substantially as claimed except for: the detection system configured to detect a dangerous condition between a person and the blade; and a reaction system having at least one brake member configured to engage and stop the rotation of the blade in the event a dangerous condition is detected. However,

Art Unit: 3724

Lokey discloses that it is old and well known in the art to use a detection system (15/16/18/19/20) and a reaction system (21/24/29) that includes at least one brake member (e.g. 24) for the purpose of preventing injury to a user (see column 1, lines 1-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a detection system and a reaction system, as taught by Lokey, in order to prevent injury to a user upon detection of a dangerous condition between the user and the blade.

As to claim 11, the modified device Shiotani et al. discloses a miter saw braking system wherein the rotating blade includes angular momentum when rotating such that at least a portion of the angular momentum is transferred to the first linkage assembly when the brake member engages the blade because the first linkage assembly is connected to the housing holding the blade.

Allowable Subject Matter

23. Claims 12-13 appear to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

24. Claims 14-18 and 20 appear to be allowable over the prior art of record.

Conclusion


25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3724

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
January 10, 2004